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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2445

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/804,815	<b>Applicant(s)</b> NEWNAM ET AL.	
	<b>Examiner</b> Jeffrey R. Swearingen	<b>Art Unit</b> 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-19,21-35 and 46-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-19,21-35 and 46-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081027</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2008 has been entered.

***Response to Arguments***

2. Applicant's arguments filed 10/27/2008 have been fully considered but they are not persuasive.

3. Applicant argues that Walker fails to teach *the program content and the episode content are downloaded to the client before the beginning of the particular television episode*. The program identification information and synchronization information are stored in the video program. Column 6, line 34. column 6, lines 43-62. The information may be downloaded before or during the viewing of the video program. Column 10, lines 1-6.

4. Applicant argues that Walker fails to teach *during the particular television episode the client receives from the server over the data communications network a particular one of the messages associated with at least one of the downloaded ITV components related to the particular television episode, the particular message being received separately from the at least one of the downloaded ITV components, the particular message including a message type identifier identifying a category of ITV content triggered via the particular message for displaying the at least one of the downloaded ITV components on the display in response to receipt of the particular message and based on the category of ITV content identified in the particular message*. The network interface receives data streams from both the CPU and the web site server. Column 9, lines 16-23. The web pages received are synchronized to the video program. Column 8, lines 6-37. The events in column 8 are the "categories" of ITV content.

5. Applicant argues that Walker fails to teach *the message type identifier identifies the at least one of the downloaded ITV components triggered via the message as being one of trivia, poll, and*

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*advertisement*. Commercials are taught in column 5, lines 50-61. Polls and trivia are taught in column 5, lines 24-35.

6. Applicant argues that Walker fails to teach *the one of the downloaded ITV components is dynamically selected for display during the particular television episode and generating the message by an ITV directing device, the message identifying the dynamically selected ITV component; and transmitting the generated message to the server by the ITV directing device*. There is no support in the specification for an ITV directing device, and it is rejected as new matter.

7. Applicant argues that Walker fails to disclose *the second message includes a second message type identifier identifying a second category of ITV components triggered via the messages as well as dynamically selected ITV content for display by the client*. This is a second message telling a second type of content to be displayed. column 8, lines 15-25 shows multiple types of content being displayed at different times in the video simulcast.

8. Applicant argues that Walker fails to disclose *generating the second message by an ITV directing device, the second message identifying the dynamically selected ITV content; and transmitting the generated second message to the server by the ITV directing device*. There is no support in the specification for an ITV directing device, and it is rejected as new matter.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 5-6, 8-19, 21-35 and 46-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,263,505 B1).

11. In regard to claim 1, 17, 46, 49, Walker disclosed:

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*receiving client software for a client to operate on a user-based hardware device that has the ability to control a display, the client software including:*

*base software for causing ITV information to be displayed on the display and including software responsive to messages from the server relating to different types of ITV interactivity, column 7, lines 33-47*

*program content applicable to a plurality of television episodes of the television program, column 4, lines 55-62 and column 4, line 27*

*episode content applicable to a particular one of the plurality of television episodes of the television program, wherein the program content and the episode content are downloaded to the client before the beginning of the particular television episode, the episode content including ITV components with ITV information for later display during the particular television episode and being received by the client before the beginning of the particular television episode, the interactive ITV components being displayed during the particular television episode in accordance with predetermined times or in response to messages from the server and prompting user interaction in response to the display of the ITV components; column 6, line 43 – column 7, line 17*

*during the particular television episode the client receiving from the server over the data communications network a particular one of the messages associated with at least one of the downloaded ITV components related to the particular television episode, the particular message being received separately from the at least one of the downloaded ITV components, the particular message including a message type identifier identifying a category of ITV content triggered via the particular message; and column 7, lines 33-62*

*displaying the at least one of the downloaded ITV components on the display in response to receipt of the particular message and based on the category of ITV content identified in the particular message. Column 7, lines 48-62*

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12. In regard to claim 2, 18, Walker disclosed:

*for a next episode, receiving new episode content with components related to the next episode prior to the beginning of the next episode without again receiving the program content and the base software. Column 10, lines 1-6*

13. In regard to claim 3, 19, Walker disclosed:

*for an episode of a different program, receiving a different program content and a different episode content without again receiving the base software prior to the beginning of the episode of the different program, and using the base software with the different program content and the different episode content for the episode of the different program. Column 7, lines 48-62*

14. In regard to claim 5, 21, Walker disclosed:

*ITV components include a question to which a user can respond. Column 5, lines 24-35*

15. In regard to claim 6, 22, Walker disclosed:

*the ITV components include a trivial question and a poll. Column 5, lines 24-35*

16. In regard to claim 8, Walker disclosed:

*displaying a point count for the trivia question that changes with time. Column 5, lines 24-35*

17. In regard to claim 9, 23, Walker disclosed:

*the base software, responsive to a user entering an answer to the trivia question, causes the answer to be provided to the server to determine if it is correct. Column 5, lines 24-35*

18. In regard to claim 10, 23, Walker disclosed:

*the base software, responsive to a user entering an answer to the trivia question, checks the answer against an answer stored as part of the episode content. Column 5, lines 24-35*

19. In regard to claim 11, 23, Walker disclosed:

*one of the client and the server corrects an answer provided to the trivia question, the client receiving from the server and displaying a point total for multiple users interacting at the same time with the server. Column 5, lines 24-35*

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20. In regard to claim 12, 24, Walker disclosed:

*the client is presentation layer independent.* Column 9, lines 10-23

21. In regard to claim 13, 25, Walker disclosed:

*the client operates with a particular type of presentation software.* Column 9, lines 10-23

22. In regard to claim 14, Walker disclosed:

*the client sending messages from the user to the server and receiving messages from other users via the server in a chat functionality during the particular episode of the program.*

Column 5, lines 24-35

23. In regard to claim 15, Walker disclosed:

*the episode content includes a plurality of advertisements, the base software being responsive to the particular message for causing one of the advertisements to be displayed.*

Column 5, lines 50-61

24. In regard to claim 16, Walker disclosed:

*the client is responsive to the receipt of the particular message and audio or video information for synchronizing the audio or video information to the type of interactivity indicated by the particular message.* Column 7, lines 48-61

25. In regard to claim 26, Walker disclosed:

*invoking a software interface for managing the server and providing messages to and receiving messages from the server.* Column 9, lines 10-23

26. In regard to claim 27, Walker disclosed:

*the server provides messages received from users to the software interface during the episode, wherein the software interface is further invoked to transmit responses to the server for forwarding to the users.* Column 9, lines 10-23

27. In regard to claim 28, Walker disclosed:

*at least some questions for responses are transmitted by the software interface to the server, and thereafter to the users on-the-fly during the particular episode.* Column 5, lines 24-61

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28. In regard to claim 29, Walker disclosed:

*the program is a television program, wherein the software interface is invoked to provide the program or episode content to the server for transmission to the users, the program or episode content being stored and timed to be received by the user in such a way that the program or episode content is synchronized to the television program to display content relevant to the program at that time.* Column 5, lines 24-61

29. In regard to claim 30, Walker disclosed:

*the program or episode content is provided to be stored in advance of being displayed and is timed to appear at selected times.* Column 9, line 41 – column 10, line 6

30. In regard to claim 31, 47, 50, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly as a supplement to the program or episode content provided to be stored in advance.* Column 5, lines 24-35; column 9, line 41 – column 10, line 6

31. In regard to claim 32, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly to appear at a desired time such that the supplemental content is relevant to the program at the desired time.* Column 5, lines 24-35

32. In regard to claim 33, Walker disclosed:

*the episode content includes a plurality of advertisements for client storage, the server sending messages to indicate to the client that the client should cause one of the stored advertisements to be displayed.* Column 5, lines 50-61

33. In regard to claim 34, Walker disclosed:

*the server provides audio or video information synchronized to textual messages to cause the textual messages to be displayed with the audio and/or video content.* Column 8, lines 6-37

34. In regard to claim 35, Walker disclosed:



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*messages can be provided to thousands of users at the same time. Column 9, lines 10-23*

35. In regard to claim 48, Walker disclosed:

*prior to receipt of any of a plurality of episodes of the video program, receiving common content related to the plurality of episodes, and prior to each episode, downloading content particular to that episode. Column 10, lines 1-6*

36. In regard to claim 51, Walker disclosed:

*at least one of the interactive components is displayed based on predetermined times during the particular episode. Column 9, lines 41-59*

37. In regard to claim 52, Walker disclosed:

*further interactive components are received and displayed on-the-fly. Column 5, lines 24-61*

38. In regard to claim 53, Walker disclosed:

*the second message type identifier identifies a layout template for formatting layout of the dynamically selected ITV content selected from a group consisting of facts, trivia questions, and poll questions. Column 5, lines 24-61*

39. In regard to claim 54, Walker disclosed:

*the dynamically selected ITV component prompts user responses to the trivia or poll questions. Column 5, lines 24-61*

40. In regard to claim 55, Walker disclosed:

*wherein the client software is stand-alone application. Column 10, lines 11-12*

41. In regard to claim 56, Walker disclosed:

*wherein the client software is a web-browser application. Column 10, lines 1-6*

42. In regard to claim 57, Walker disclosed:

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*the graphics data is preloaded by the client and the base software retrieves the preloaded graphics data that achieves the particular layout format. HTML encoding. Column 2, lines 2-3*

43. In regard to claim 58, Walker disclosed:

*the base software dynamically formats the dynamically selected ITV content based on the second message type identifier. HTML tags. Column 2, lines 2-3.*

44. In regard to claim 59, Walker disclosed:

*the message type identifier identifies the at least one of the downloaded ITV components triggered via the message as being one of trivia, poll, and advertisement. Commercials are taught in column 5, lines 50-61. Polls and trivia are taught in column 5, lines 24-35.*

45. In regard to claim 60, Walker disclosed:

*generating the message by an ITV directing device, the message identifying the dynamically selected ITV component; and column 7, lines 48-62*

*transmitting the generated message to the server by the ITV directing device. column 7, lines 48-62*

46. In regard to claim 61, Walker disclosed:

*the particular message is received after the downloading of the corresponding ITV component, and prompts display of the downloaded corresponding ITV component. Column 7, lines 48-62*

47. In regard to claim 62, Walker disclosed:

*during the particular television episode, the client receiving from the server over the data communications network a second message, the second message including a second message type identifier identifying a second category of ITV components triggered via the message, the second message further including dynamically selected ITV content for display by the client; and column 7, lines 33-62*

*the base software receiving the second message, retrieving from the second message the second message type identifier, retrieving a layout template stored in the client specific to the*

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*second message type identifier, and formatting the dynamically selected ITV content in a particular layout format based on the retrieved layout template for causing to be displayed on the display the dynamically selected ITV content in the particular layout format, wherein the second message type identifier minimizes data transfer over the data communications network by avoiding transmitting with the second message specific graphics data that achieves the particular layout format.* Column 7, lines 48-62

48. In regard to claim 63, Walker disclosed:

*generating the second message by an ITV directing device, the second message identifying the dynamically selected ITV content; and column 7, lines 48-62*  
*transmitting the generated second message to the server by the ITV directing device.*  
column 7, lines 48-62

### ***Claim Rejections - 35 USC § 112***

49. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

50. Claims 60 and 63 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claims 60 and 63 contain matter critical or essential to the practice of the invention, but not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claims 60 and 63 refer to an ITV directing device. Nowhere in the specification or the specification citation provided by Applicant is any mention of an ITV directing device.

### ***Conclusion***

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

52. Schaefer et al. US 20020124252

53. Srinivasan et al. US 6,357,042

54. Zigmond et al. US 6,698,020

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- 55. Elderling et al. US 6,704,930
- 56. Billmaier et al. US 6,710,815
- 57. Swix et al. US 6,718,551
- 58. Marshall et al. US 6,735,487
- 59. Tomsen US 7,313,802
- 60. Searls, Doc. "Linux for Suits: Now What: Are We Going to Let AOL Turn the Net into TV 2.0..."

Linux Journal. April 2000. Volume 2000, Issue 72. Article 29. Specialized Systems Consultants, Inc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Donaghue can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen  
Examiner  
Art Unit 2445

/Jeffrey R. Swearingen/  
Examiner, Art Unit 2445